

In the Claims

Amend Claim 1 has been amended to read as follows:

- 5 sub 1
a
1. (Amended) A method for manufacturing a guidewire having a substantially cylindrical mandrel, said mandrel having one or more segments each having a diameter not exceeding a maximal diameter, the method comprising:
- providing a wire of a diameter greater than the maximal diameter; and
- reducing the diameter of the wire to less than the maximal diameter such that a mandrel is obtained whose diameter is less than the maximal diameter over substantially the entire length of the mandrel.

REMARKS

The Office Action dated September 12, 2002, has been carefully considered. In response to the Office Action, the Applicant has amended the application. Applicant requests that the Examiner consider the following remarks, and then pass the application to allowance.

Drawing Corrections

The drawing figures have been corrected in accordance with the Examiner's suggestions. Specifically, FIG. 5 has been amended to show D_M and k , wherein D_M is depicted as equivalent to the largest diameter, D_1 , and k is the number of segments of the guidewire, which is 3. Approval of the corrections is respectfully requested.

Pending Claims

Claims 1-7 remain pending.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claims 1 was rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 has been amended to remove the term "preselected," which lacked antecedent basis.

Art Rejection Under 35 U.S.C. § 102(b)

Claims 1-5 were rejected under 35 U.S.C. § 102(b) as anticipated by Morrison (U.S. Pat. No. 4,619,274).

Claim 1 has been amended to recite "reducing the diameter of the wire to less than the maximal diameter such that a mandrel is obtained whose diameter is less than the maximal diameter over substantially the entire length of the mandrel."

This feature is not disclosed in Morrison. According to the discussion in col. 2 of Morrison, grinding of the core potion begins at tapered portion 12b, and continues through portions 12c, 12d, 12e, 12f, and 12g. There is no discussion of grinding of the major portion of the length of the core element—that is, portion 12a. Thus Morrison does not disclose "reducing the diameter of the wire to less than the maximal diameter *such that a mandrel is obtained whose diameter is less than the maximal diameter over substantially the*

entire length of the mandrel." For this reason at least, Morrison does meet all the limitations of Claim 1, and the withdrawal of the rejection under 35 U.S.C. § 102(b) based on Morrison is respectfully requested.

Art Rejection Under 35 U.S.C. § 103(a)

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over Morrison in view of Applicant's Admitted Prior Art. However, Morrison does not teach or suggest the presently claimed invention. Specifically, "reducing the diameter of the wire to less than the maximal diameter such that a mandrel is obtained whose diameter is less than the maximal diameter over substantially the entire length of the mandrel" would not have been obvious to one of ordinary skill in the art because the more expedient course of action would have been to reduce the amount of grinding required, and this would more naturally be achieved by selecting a starting wire whose diameter matches the maximal diameter, as Morrison does, in order to not have to grind the wire down for at least a portion of the wire. Applicant has discovered, however, that certain desired characteristics attend the grinding of the wire. Among these are the reduction of whipping problems, overcoming coating limitations, and more faithful transmission of torque forces. These advantages are not recognized by the applied prior art, and one of ordinary skill in the art would therefore not be motivated to modify the prior art in the manner of the presently claimed invention. Thus the feature of "reducing the diameter of the wire to less than the maximal diameter such that a mandrel is obtained whose diameter is less than the maximal diameter over

substantially the entire length of the mandrel" would not have been obvious to one of ordinary skill in the art, and withdrawal of the obviousness rejection is respectfully requested.

Conclusion

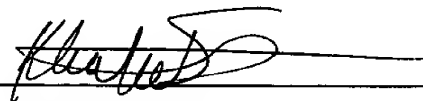
In view of the preceding discussion, Applicant respectfully urges that the claims of the present application define patentable subject matter and should be passed to allowance. Such allowance is respectfully solicited.

If the Examiner believes that a telephone call would help advance prosecution of the present invention, the Examiner is kindly invited to call the undersigned attorney, Mr. Khaled Shami, at (650) 622-2332.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: _____



Khaled Shami
Registration No. 38,745

Post Office Box 1404
Alexandria, Virginia 22313-1404
(650) 622-2332

Date: December 12, 2002

Marked-Up Copy of Changes

In the Claims

Claim 1 has been amended as follows:

1. (Amended) A method for manufacturing a guidewire having a substantially cylindrical mandrel, said mandrel having one or more segments each having a diameter not exceeding a maximal diameter, the method comprising:
providing a wire of a diameter greater than the maximal diameter; and
reducing the diameter of the wire to less than the [preselected] maximal diameter
such that a mandrel is obtained whose diameter is less than the maximal diameter over substantially the entire length of the mandrel.



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Part of #6

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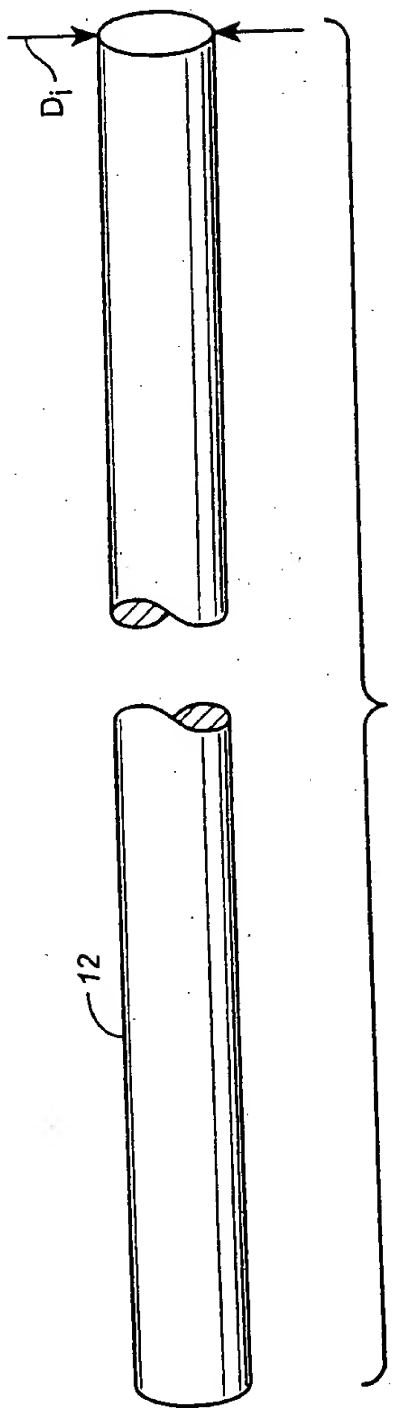


FIG. 4

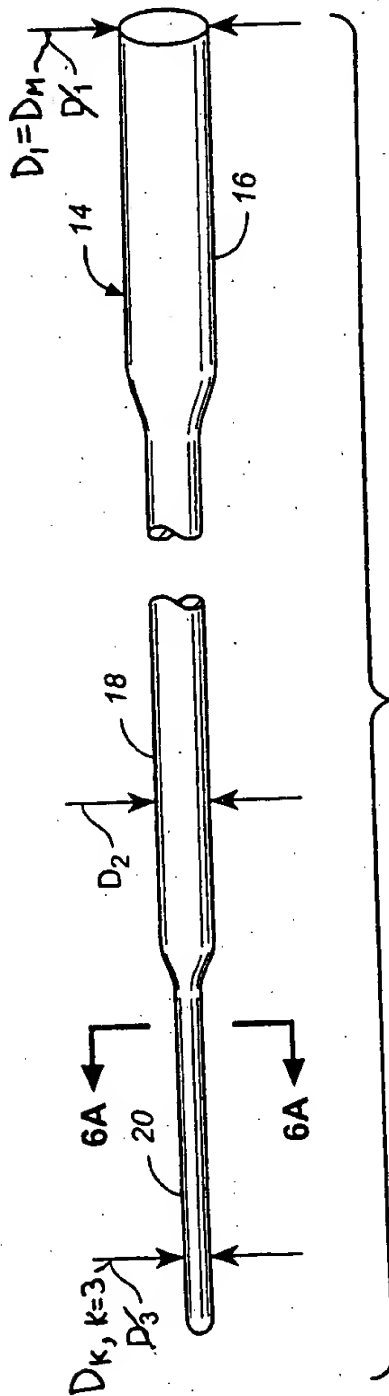


FIG. 5

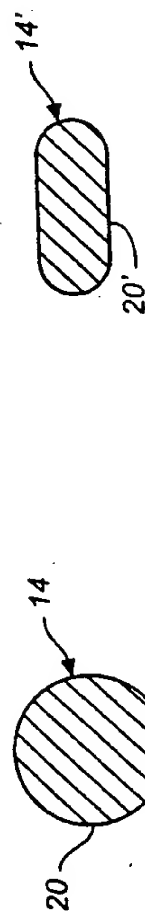


FIG. 6A

FIG. 6B

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